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EXAMINER

CARDONE, JASON D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 34

Application Number: 09/095,325
Filing Date: June 10, 1998
Appellant(s): EGGLESTON ET AL.

W. Todd Baker
(Reg. No. 45,265)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 21, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 33-114 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 33-114 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth-in prior Office Action, Paper No. 25, filed June 28, 2002.

(11) Response to Arguments

Applicant's arguments filed January 21, 2003 have been fully considered but they are not persuasive.

(A) Appellants disagrees with the 112 1st rejection of Group I (claims 104, 105, and 109-114) towards the claimed limitation "a forward component to forward messages". Appellants point out page 8 (lines 14-25), figure 4 (steps 430-444), page 16 (lines 12-34), and page 8 (lines 14-17).

As to point (A), independent claims 104, 109, and 113 disclose upon receiving a reply message at a forwarding component associated with a host system, forwarding the received message to a message recipient. Page 8 (lines 14-25), discloses an electronic mail post office that can be coupled/located in different parts of the network (ie. a program running on the communication server). Figure 4 (steps 430-444), discloses generating email upon the client, applying filters and sending it to the communication server. The communication server forwards the email but does not show where the email is forward to. The host/server is the only other computer upon

Art Unit: 2142

within the drawing, it could be considered that the communication server forwards the email to the host/server. Page 16 (lines 12-34) discloses filtering programs in the client and being able to send once there is a low cost connection in the network. One of skill in the art, at the time the application was filed, would not have recognized that the application was in possession of the invention as claimed, in view of the disclosure of the application as filed, since an explicit limitations (ie. a forward component associated with a host system, forwarding the received message to a message recipient) in a claim is not present in the written description [See Paper No. 21 for court citing]. It can be conceived that the email post office is upon the communication but it is not directly associated with the host. Also, there is no mention (within the citations of the appellant or the specification) of forwarding the electronic mail to the message recipient. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing describes in the reference, and that it would be recognized by persons of ordinary skill. Inherence, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" (citations omitted). Furthermore, each claim must include all elements which applicant has described as essential [See Paper No. 21 for court citing].

(B) Appellants disagrees with the 112 1st rejection of Group II and IV (claims 56-63 and 65 and claims 33-55, 64, and 66-68, respectively) towards the claimed limitation "a first address at or associated with the host system as seen from the plurality of clients

Art Unit: 2142

as the address of the mobile client". Applicants point out that the claims do not require this feature. The claims of Groups II and IV define that messages received by a message recipient appear to have originated at an email address associated with the host. That is, "the message recipient is unaware whether the message sender sent the message from his mobile client or from his terminal wired to the host system".

Appellants submit that "one in the art in the 1995 timeframe would have understood from the figures and the corresponding description thereof that all email messages to and from the mobile unit are processed and/or recorded by the post office which includes the mailbox having the first address". Appellants point out figure 4 (steps 408-412, 430-436), page 16 (lines 12-34), figures 7 and 8, page 18 (lines 4-6), figure 9, and page 22 (lines 22-30)

As to point (B), independent claims 33, 54-56, 60, 64, and 65 disclose a first address at or associated to the host system as seen from the plurality of clients/senders as the address of the user (ie. mobile client). Appellants define the claims that the message recipient is unaware where the message is sent. It is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Appellant admits to one in the art, in the timeframe of 1995, would have understood from the specification the use of the shared addressing that is claimed within this application. Appellant does not disclose physical evidence of such an observance. Even if there was physical evidence, one of ordinary skill, in the

Art Unit: 2142

art, in 1995, would not have been able to understand and create the claimed invention by the figures and description of the instant application, since an explicit limitation (ie. a first address at or associated to the host system as used by the plurality of clients as the address of the mobile client, shared addressing, receiving messages directed to a first address at the host system....) in a claim is not present in the written description (as shown below) [See Paper No. 21 for court citing]. As to the citations, figure 4 (steps 408-412) discloses querying the host for email. Figure 4 (steps 430-444), discloses generating email upon the client, applying filters and sending it to the communication server. Page 16 (lines 12-34) discloses filtering programs in the client and being able to send once there is a low cost connection in the network. Figures 7 and 8 disclose receiving summary information, at the client, before the client chooses to forward the email to itself from the host. Page 18 (lines 4-6) discloses the post office filters email. Figure 9 discloses correspond requests and replies through the communication server. Page 22 (lines 22-30) discloses conservation of bandwidth with the use of optimizing the corresponding replies to requests. These citations consist of how the mobile client receives an email. The mobile client (communication server) can query the host to receive the mobile client's email. The email maybe filtered or optimized or summarized for the mobile client. There is no mention (within the citations of the appellant or the specification) of shared addressing between the mobile client (or user) and the host for receiving messages from senders (ie. receiving messages directed to a first address at/associated to the host" for the mobile client). Also, the idea of "transparency" (used at the header of the applicants' argument) is not discloses within the instant application.

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing describes in the reference, and that it would be recognized by persons of ordinary skill. Inherence, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" (citations omitted). Furthermore, each claim must include all elements which applicant has described as essential.

(C) Appellants disagrees with the 112 1st rejection of Group III and IV (claims 69-103 and 106-108 and claims 33-55, 64, and 66-68, respectively) towards the claimed limitation "continuously forwarding". Appellants point out figure 3 (steps 320-324) and page 12 (lines 1-29).

As to point (C), independent claims 133, 54, 55, 69, 92, 95, 98, and 106 disclose continuously forwarding incoming messages from the host system to the mobile client. Figure 3 (steps 320-324) show, once the virtual session is established, the VSM (Virtual Session Manager) queries the host/post office for email. The host/post office receives new email and forwards the new email to the VSM, which forwards it to the client. The client acknowledges the email and, through the VSM, updates the post office box. There are "dots" pictured in the drawing but no mention of a continuous loop of forwarding email to the client. Page 12 (lines 1-29) discloses the steps of figure 3. The page, also, discloses the email is delivered in a sessionless mode, the amount of time the communication channel is tied up is kept to a minimum. If this is true, continuous forwarding of email would, at one point, tie up the communication channel resulting in a

Art Unit: 2142

conclusion that the instant application has been trying to solve (ie. low traffic with low cost communications, "rate governing"). Further down page 12 (lines 29-34) and page 13 (lines 1-3) disclose that rather than new data from the host pushed down to the communication server (VSM), most of data exchanges are preferably initiated, at some predetermined interval, by the communication manager. This citation discloses that the forwarding of email, from the host/post office, is not continuous and in fact only done by intervals initiated by the communication server (specifics of how this is done are not disclosed). The idea of "the newly received mail is 'continuously forwarded' (ie. push not pulled) from the host system to the mobile client" is not represented by the specification. In fact, the communication server, working with the client, does pull the email from the host for the mobile client. Since, the specification discloses that the communication server queries the host in intervals, this is contradictory of the claimed invention of the host "continuously forwarding" the incoming email. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing describes in the reference, and that it would be recognized by persons of ordinary skill. Inherence, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" (citations omitted). Furthermore, each claim must include all elements which applicant has described as essential.

Art Unit: 2142

(12) Conclusion

The office has acknowledged the request for interference by applicants, filed 9/18/01 (Paper No. 20) but (as shown above) the instant claims are not in order for allowance at this time. See MPEP § 2301.1(c).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adler et al., Patent No. 6,157,630, discloses managing email accounts upon a host server. Verjinsji, "PHASE", discloses managing IP addresses for multiple portable clients. Motorola, "Airmobile", discloses server push of emails.

Art Unit: 2142

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


Jason D. Cardone
Examiner
Art Unit 2142

June 17, 2003

Conferees

Mark Powell


MARK POWELL
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